

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: § Group Art Unit: 2155
Newton J. Smith, Jr., *et al.* §
Serial No.: 09/942,757 § Examiner: Bruckart, Benjamin R.
Filed: 08/30/2001 § Atty Docket No.: AUS920010459US1
Title: Customized Tours Using § Customer No.: 34533
Handheld Devices § Confirmation No.: 9992
§

Mail Stop: Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

AMENDED APPEAL BRIEF

Honorable Commissioner:

This is an Amended Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Notification of Non-Compliant Appeal Brief mailed on August 2, 2006. The original Appeal Brief, which this filing amends, was filed on July 12, 2006, pursuant to 37 CFR § 41.37 in response to the Final Office Action of February 15, 2006, ('Final Office Action') and pursuant to the Notice of Appeal filed May 12, 2006.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Eighty-one claims are filed in the original application in this case. Claims 1-81 are rejected in the Final Office Action. Claims 1-81 are on appeal.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to the specification by page and line number and to the drawings by reference characters. There are three independent claims in the present case, claims 1, 28, and 55. Claim 1 is a method claim. Claims 28 and 55 claim respectively system and computer program product aspects of the method of claim 1.

Claim 1 of the present application claims:

1. A method for communication of location specific content to client devices, the method comprising the steps of:

identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and

wherein the location specific device comprises a location identification code;

recording user preferences for the client device;

selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

transmitting the selected content through the location specific device to the client device for presentation; and

enabling retention of the content within the client device for a period of time.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph, for independent claim 28 is identified as follows. Note the precise correspondence with the elements of claims 1 and 55:

28. A system for communication of location specific content to client devices, the system comprising:

means for identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

means for recording user preferences for the client device;

means for selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

means for transmitting the selected content through the location specific device to the client device for presentation; and

means for enabling retention of the content within the client device for a period of time.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph, for independent claim 55 are identified as follows. Note the precise correspondence with the elements of claims 1 and 28:

55. A computer program product for communication of location specific content to client devices, the computer program product comprising:
a recording medium;

means, recorded on the recording medium, **for identifying** a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

means, recorded on the recording medium, **for recording** user preferences for the client device;

means, recorded on the recording medium, **for selecting**, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

means, recorded on the recording medium, **for transmitting** the selected content through the location specific device to the client device for presentation; and

means, recorded on the recording medium, **for enabling** retention of the content within the client device for a period of time.

The portion of the original specification that is most pertinent to claim 1 of the present application is pages 6, 10, 12 – 15 and Figure 3. The subject matter of claim 1 is concisely summarized as follows with a description beginning at line 26 of page 12 in the original application and with reference numbers in parenthesis referencing Figure 3:

Turning now to Figure 3, a further aspect of the invention is illustrated as methods for communication of location specific content to client devices. Typical embodiments as shown in Figure 3 include identifying (202) a client device (104) at a location of a location specific device (108), wherein the client device includes client device attributes, the client device attributes include a client device identification code, and wherein the location specific device includes a location identification code (212). Typical embodiments also include recording (204) user preferences (218) for the client device and selecting (206), in dependence upon the user preferences (218) for the client device and upon the location identification code (212), content (216) for transmission to the client device. Typical embodiments further include transmitting (208, 209) the selected content through the location specific device (108) to the client device (104) for display; and enabling (210) retention of the content within the client device for a period of time. In many embodiments, a location identification code comprises a network address, and a client device identification code comprises a network address.

Because claims 28 and 55 contain elements parallel to claim 1, the concise summary above of claim 1 is applicable also to claims 28 and 55. The acts described in this concise summary above of the method of claim 1 are also the acts corresponding to each claimed function in the means

plus functions claimed in claims 28 and 55 according to 35 U.S.C. § 112, sixth paragraph. The means for carrying out the acts described in claims 28 and 55 include automated computing machinery and machine-readable information concisely described at pages 7 – 8 in the original specification stating:

In this specification, the present invention is described to a large extent in terms of methods for communication of location specific content to client devices. Persons skilled in the art, however, will recognize that any computer system that includes suitable programming means and suitable communications means for operating in accordance with the disclosed methods also falls well within the scope of the present invention.

Suitable programming means include any means for directing a computer system to execute the steps of the method of the invention, including for example, systems comprised of processing units and arithmetic-logic circuits coupled to computer memory, which systems have the capability of storing in computer memory data elements and programmed steps of the method of the invention for execution by a processing unit as computer program instructions, which computer memory includes electronic circuits configured to store data and program instructions. The invention also is embodied in a computer program product, such as a diskette or other recording medium, for use with any suitable data processing system.

Suitable communications means includes any method of wireless data communications including various infrared and radio means including for example wireless LANs implemented in accordance with IEEE standard number 802.11. Suitable communications means includes any method of wireless data communications including various infrared and radio means including for example so-called Bluetooth piconets implemented in accordance with the well known de facto industry standard known as the “Bluetooth Specification,” a specification for short range radio links among mobile personal computers, mobile phones, and other portable devices.

Embodiments of a computer program product typically are implemented by use of any recording media for machine-readable information, including magnetic media, optical media, or other suitable media. Persons skilled in the art will immediately recognize that any computer system having suitable programming means will be capable of executing the steps of the method of the invention as embodied in a program product. Persons skilled in the art will recognize immediately that, although most of the exemplary embodiments described in this specification are oriented to software installed and executing on computer hardware, nevertheless, alternative embodiments implemented as firmware or as hardware are well within the scope of the present invention.

GROUNDS OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Applicants provide the following concise statement for each ground of rejection:

1. Claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, 51-54, 55, 58-60, 68-69, 74, and 78-81 are rejected under 35 U.S.C § 102(e) as being anticipated by Eldering, *et al.* (U.S. Publication No. 20020111154).
2. Claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67 are rejected under 35 U.S.C § 103(a) as being anticipated by Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Balog, *et al.* (U.S. Publication No. 20020022453).
3. Claims 16-19, 21, 43-46, 48, 70-73, and 75 are rejected under 35 U.S.C § 103(a) as being anticipated by Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Hicks, III, *et al.* (U.S. Publication No. 20040261112).
4. Claims 22, 23, 49, 50, 76, and 77 are rejected under 35 U.S.C § 103(a) as being anticipated by Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Kim, *et al.* (U.S. Publication No. 20020052925).

ARGUMENT

Applicants present the following arguments pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the two grounds of rejection in the present case.

**ARGUMENT REGARDING THE FIRST GROUND OF REJECTION:
CLAIMS 1, 4-6, 14-15, 20, AND 24-27 ARE UNPATENTABLE
UNDER 35 U.S.C § 102(E) OVER ELDERING**

Claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, 51-54, 55, 58-60, 68-69, 74, and 78-81 stand rejected under 35 U.S.C § 102(e) as being anticipated by Eldering, *et al.* (U.S. Patent Application Publication No. 2002/0111154). To anticipate claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, 51-54, 55, 58-60, 68-69, 74, and 78-81 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Eldering must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Eldering must enable Applicants' claims. Eldering does not meet either requirement and therefore does not anticipate Applicants' claims.

Eldering Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Eldering does not disclose each and every element of claim 1, and Eldering therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Claim 1 of the present application claims:

1. A method for communication of location specific content to client devices, the method comprising the steps of:

identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

recording user preferences for the client device;

selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

transmitting the selected content through the location specific device to the client device for presentation; and

enabling retention of the content within the client device for a period of time.

Eldering Does Not Disclose Identifying A Client Device At A Location Of A Location Specific Device, Wherein The Client Device Comprises Client Device Attributes, The Client Device Attributes Comprising A Client Device Identification Code, And Wherein The Location Specific Device Comprises A Location Identification Code

The first element of claim 1 claims “identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.” To reject claim 1, the Office Action equates the tower receivers of Eldering with the location specific device claimed in the present application. More specifically, regarding the first element of claim 1, the Final Office Action at pages 2 and 9 states:

identifying a client device at a location of a location specific device (Eldering: page 3, para 37; wireless device=client device; location specific device=towers); wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code (Eldering: page 5, para 54; subscribers associated with a type of identification), and wherein the location specific device comprises a location identification code (Eldering: page 3, para 37; location is identified by the wireless system; page 5, para 51);

...

The Eldering reference teaches ‘a location specific device’ through the teachings of the towers that the device connects with. Using two or three towers and determining the difference in time that the signal is received by the receiver, the

location of the device can be determined. The towers are location specific. Para 34 teaches a plurality of towers based on the networks size and in difference areas like states. The location specific device comprises a location identification code is based on the determination by the towers. That location is identified by store or product in a database to predict and track a users profile page 5, para 51.

The Eldering reference teaches client specific attributes and client device identification codes. The term attributes is broad and is sufficiently taught by the characteristics on page 4, para 40. The actual identification code is taught on page 5, para 54 where subscribers are associated with a type of identification to be referenced to by service/content providers.

That is, the Final Office Action takes the position that Eldering at paragraphs 0037, 0054, 0051, 0034, and 0040 discloses the first element of claim 1. Applicants respectfully note in response, however, that what Eldering at paragraph 0037 in fact discloses is:

[0037] When the wireless device 110 initiates communications, a signal is sent from the wireless device 110 and is received by the receivers 150. The appropriate receiver 150 forwards the signal based on who the service provider is, whether they actually provide service in that location or are contracting with a local provider, and the destination of the communication. The location of the subscriber can be identified by the wireless system. For example, determining the difference in time that the signal is received at three towers or the difference in the angle that the signal is received at two towers can identify the location. Alternatively, a GPS chipset that is located within the device can determine the location of the subscriber.

That is, Eldering at paragraph 0037 discloses a wireless system that uses two or more tower receivers to estimate the position of a wireless device. In contrast to Eldering, Applicants describe the location specific device at the paragraph beginning at page 6, line 5, in the original application stating:

Embodiments of the present invention typically implement two-way exchanges of information between a visitor's client device and a location specific device mounted inside or near an exhibit or other location of interest. As the visitor approaches the exhibit, the location specific device communicates with the visitor's client device and negotiates the appropriate content based on the capabilities of the visitor's client device, as well as the visitor's stated preferences.

That is, an example of the location specific device is described as a device mounted inside or near an exhibit or other location of interest. Eldering's wireless system using two or more tower receivers to estimate the position of a wireless device is not the same as identifying a client device at a location of a location specific device as claimed in the present application because Eldering has no single location for a location specific device. The wireless system of Eldering instead merely estimates the location of the wireless device somewhere in the wireless system using multiple receiver towers. Eldering never estimates the wireless device at any location of a single tower. In fact, Eldering cannot do so, because Eldering uses triangulation with multiple towers to estimate the location of the wireless device. The wireless system of Eldering, therefore, does not identify a client device at a location of a location specific device as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0037 does not even mention 'client device attributes,' 'client device identification code,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not disclose each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0054, the Office Action attempts to equate the identification associated with a subscriber in paragraph 0054 of Eldering with the client device identification code in the claims in the present application. Applicants respectfully note in response that what Eldering at paragraph 0054 in fact discloses is:

[0054] For example, if the service/content provider 250 is an advertiser for a high-end kitchen store they may wish to target ads to subscribers having a specific profile (i.e., upper income) that are either traveling within a 50 mile radius of the store (or are predicted to do so). As would be obvious to one of ordinary skill in the art, the subscribers would have to be associated with some type of identification so that the service/content provider 250 could receive or retrieve data of interest to them from the subscriber location database 310. In a preferred embodiment, the service/content provider 250 would not be given access to the raw subscriber data but would instead be given access to aggregated subscriber

data. The aggregated data may be grouped by targeted subscribers or by targeted location.

That is, Eldering at paragraph 0054 discloses associating with a subscriber some type of identification so that a service/content provider can receive or retrieve data of interest to the subscriber from the subscriber location database. A client device identification code as claimed in the present application, however, is an attribute of a client device. As indicated in paragraph 0054 of Eldering quoted above, Eldering's identification associated with a subscriber identifies a person having a specific profile—not a client device. That is, Eldering's identification associated with a subscriber is an attribute of the subscriber in Eldering—not an attribute of the client device. As for the other limitations in the first element of claim 1, Eldering at paragraph 0054 does not even mention 'identifying a client device at a location of a location specific device,' 'client device attributes,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not disclose each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0051, the Office Action attempts to equate the data from a location profile/attribute database in Eldering with the location identification code in the present application. Applicants respectfully note in response that what Eldering at paragraph 0051 in fact discloses is:

[0051] The subscriber profiler 230 may use the data from the location profile/attribute database 320 to identify the type of establishments that the subscriber 210 may pass on the predicted routes. Furthermore, the subscriber profiler 230 may generate a profile of the subscriber based on the data from the two databases 310, 320. The subscriber profile may include a probabilistic determination of the demographic make-up (i.e., race, age, gender, income), and the preferences (i.e., product, store) of the subscriber 210.

That is, Eldering at paragraph 0051 discloses using the data from a location profile/attribute database to identify the type of establishments that a subscriber may pass on a predicted route.

The location identification code of the claims of the present application is included in the location specific device. By contrast, the data of Eldering is not comprised in a location specific device. Instead, the data of Eldering is stored in a location profile/attribute database, which itself is not comprised in a location specific device. Furthermore, the data of Eldering is a profile of establishments around a location, not a location identification code. As for the other limitations in the first element of claim 1, Eldering at paragraph 0051 does not even mention ‘identifying a client device at a location of a location specific device,’ ‘client device attributes,’ ‘client device identification code,’ or ‘identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.’ Because Eldering does not disclose each and every element and limitation of Applicants’ claims, Eldering does not anticipate Applicants’ claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0034, the Office Action attempts to equate the towers of Eldering with the location specific device in the present application. Applicants respectfully note in response that what Eldering at paragraph 0034 in fact discloses is:

[0034] As illustrated, the wireless network 100 consists of three towers 140. As one of ordinary skill in the art would recognize, the wireless network 100 would consist of a plurality of towers, with the number depending on the size of the network. As illustrated each of the towers 140 include multiple receivers 150. In practice, different wireless service providers operating out of that location probably have their own receiver 150 on the tower 140. The service provider may only handle calls for their customers or it may also contract with other wireless providers to provide service for their customers. For example, if Verizon did not provide wireless service in California, they may contract with Pacific Bell for Pacific Bell to handle the wireless communications for them in California.

That is, Eldering at paragraph 0034 merely describes a wireless network that consists of three towers, each of the towers including multiple receivers. As described above, Eldering’s wireless system does not disclose identifying a client device at a location of a location specific device as claimed in the present application because Eldering has no single location for a location specific device. The wireless system of Eldering instead merely estimates the location of the wireless

device somewhere in the wireless system using multiple receiver towers or a GPS chipset. Eldering never estimates the wireless device at any location of a single tower. In fact, Eldering cannot do so, because Eldering uses triangulation with multiple towers to estimate the location of the wireless device. The wireless system of Eldering, therefore, does not identify a client device at a location of a location specific device as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0034 does not even mention ‘identifying a client device at a location of a location specific device,’ ‘client device attributes,’ ‘client device identification code,’ ‘location identification code,’ or ‘identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.’ Because Eldering does not disclose each and every element and limitation of Applicants’ claims, Eldering does not anticipate Applicants’ claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0040, the Office Action attempts to equate the subscriber characteristics in a subscriber profile of Eldering with the client device attributes in the present application. Applicants respectfully note in response that what Eldering at paragraph 0040 in fact discloses is:

[0040] Thus in a preferred embodiment, characteristics about the subscriber (i.e., a subscriber profile) will be known so that the delivery of advertisements, services and information can be tailored (targeted) to that subscriber. For example, if you know that the subscriber likes nice cars you may send him an advertisement for the local BMW dealers in the local area. The characteristics about the subscriber may include demographics, psychographics, product preferences, service preferences, hobbies, likes, dislikes, other categories, or combinations thereof. The characteristics may be provided by the subscriber, may be generated based on actions of the subscriber, or some combination thereof. The subscriber may provide the information by filling out a survey or may simply provide any information they decide is relevant and worth sharing. The actions that may be used to characterize the subscriber include but are not limited to purchases (products and/or services), channel changes, Internet browsing, locations visited, routes, other transactions, and combinations thereof.

That is, Eldering at paragraph 0040 discloses specifying subscriber characteristics in a subscriber profile so that the delivery of advertisements, services, and information can be tailored to that

subscriber. Client device attributes as claimed in the present application, however, are attributes of a client device. Eldering's subscriber characteristics in a subscriber profile describe a person—not a client device. That is, Eldering's subscriber characteristics in a subscriber profile are attributes of a person—not attributes of a client device. Furthermore, Eldering's subscriber characteristics in a subscriber profile cannot be client device attributes as claimed in the present application because the subscriber characteristics in a subscriber profile does not include a client device identification code as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0040 does not even mention 'identifying a client device at a location of a location specific device,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not disclose each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Eldering Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Eldering disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Eldering must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Eldering places Applicants' claims in the possession of a person of ordinary skill in the art, Eldering is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Eldering is in fact legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Claim 1 of the present application claims:

1. A method for communication of location specific content to client devices, the method comprising the steps of:
 - identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;
 - recording user preferences for the client device;
 - selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;
 - transmitting the selected content through the location specific device to the client device for presentation; and
 - enabling retention of the content within the client device for a period of time.

Eldering Does Not Place In The Possession Of One Of Ordinary Skill In The Art Identifying A Client Device At A Location Of A Location Specific Device, Wherein The Client Device Comprises Client Device Attributes, The Client Device Attributes Comprising A Client Device Identification Code, And Wherein The Location Specific Device Comprises A Location Identification Code

The first element of claim 1 claims "identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device

comprises a location identification code.” To reject claim 1, the Office Action equates the tower receivers of Eldering with the location specific device claimed in the present application. More specifically, regarding the first element of claim 1, the Final Office Action at pages 2 and 9 states:

identifying a client device at a location of a location specific device (Eldering: page 3, para 37; wireless device=client device; location specific device=towers); wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code (Eldering: page 5, para 54; subscribers associated with a type of identification), and wherein the location specific device comprises a location identification code (Eldering: page 3, para 37; location is identified by the wireless system; page 5, para 51);

...

The Eldering reference teaches ‘a location specific device’ through the teachings of the towers that the device connects with. Using two or three towers and determining the difference in time that the signal is received by the receiver, the location of the device can be determined. The towers are location specific. Para 34 teaches a plurality of towers based on the networks size and in difference areas like states. The location specific device comprises a location identification code is based on the determination by the towers. That location is identified by store or product in a database to predict and track a users profile page 5, para 51.

The Eldering reference teaches client specific attributes and client device identification codes. The term attributes is broad and is sufficiently taught by the characteristics on page 4, para 40. The actual identification code is taught on page 5, para 54 where subscribers are associated with a type of identification to be referenced to by service/content providers.

That is, the Final Office Action takes the position that Eldering at paragraphs 0037, 0054, 0051, 0034, and 0040 discloses the first element of claim 1. Applicants respectfully note in response, however, that what Eldering at paragraph 0037 in fact discloses is:

[0037] When the wireless device 110 initiates communications, a signal is sent from the wireless device 110 and is received by the receivers 150. The appropriate receiver 150 forwards the signal based on who the service provider is, whether they actually provide service in that location or are contracting with a local provider, and the destination of the communication. The location of the subscriber can be identified by the wireless system. For example, determining the difference

in time that the signal is received at three towers or the difference in the angle that the signal is received at two towers can identify the location. Alternatively, a GPS chipset that is located within the device can determine the location of the subscriber.

That is, Eldering at paragraph 0037 discloses a wireless system that uses two or more tower receivers to estimate the position of a wireless device. In contrast to Eldering, Applicants describe the location specific device at the paragraph beginning at page 6, line 5, in the original application stating:

Embodiments of the present invention typically implement two-way exchanges of information between a visitor's client device and a location specific device mounted inside or near an exhibit or other location of interest. As the visitor approaches the exhibit, the location specific device communicates with the visitor's client device and negotiates the appropriate content based on the capabilities of the visitor's client device, as well as the visitor's stated preferences.

That is, an example of the location specific device is described as a device mounted inside or near an exhibit or other location of interest. Eldering's wireless system using two or more tower receivers to estimate the position of a wireless device is not the same as identifying a client device at a location of a location specific device as claimed in the present application because Eldering has no single location for a location specific device. The wireless system of Eldering instead merely estimates the location of the wireless device somewhere in the wireless system using multiple receiver towers. Eldering never estimates the wireless device at any location of a single tower. In fact, Eldering cannot do so, because Eldering uses triangulation with multiple towers to estimate the location of the wireless device. The wireless system of Eldering, therefore, does not identify a client device at a location of a location specific device as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0037 does not even mention 'client device attributes,' 'client device identification code,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not place in possession of one

of ordinary skill in the art each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0054, the Office Action attempts to equate the identification associated with a subscriber in paragraph 0054 of Eldering with the client device identification code in the claims in the present application. Applicants respectfully note in response that what Eldering at paragraph 0054 in fact discloses is:

[0054] For example, if the service/content provider 250 is an advertiser for a high-end kitchen store they may wish to target ads to subscribers having a specific profile (i.e., upper income) that are either traveling within a 50 mile radius of the store (or are predicted to do so). As would be obvious to one of ordinary skill in the art, the subscribers would have to be associated with some type of identification so that the service/content provider 250 could receive or retrieve data of interest to them from the subscriber location database 310. In a preferred embodiment, the service/content provider 250 would not be given access to the raw subscriber data but would instead be given access to aggregated subscriber data. The aggregated data may be grouped by targeted subscribers or by targeted location.

That is, Eldering at paragraph 0054 discloses associating with a subscriber some type of identification so that a service/content provider can receive or retrieve data of interest to the subscriber from the subscriber location database. A client device identification code as claimed in the present application, however, is an attribute of a client device. As indicated in paragraph 0054 of Eldering quoted above, Eldering's identification associated with a subscriber identifies a person having a specific profile—not a client device. That is, Eldering's identification associated with a subscriber is an attribute of the subscriber in Eldering—not an attribute of the client device. As for the other limitations in the first element of claim 1, Eldering at paragraph 0054 does not even mention 'identifying a client device at a location of a location specific device,' 'client device attributes,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not place in possession of one of ordinary skill in the art each and every element and limitation of

Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0051, the Office Action attempts to equate the data from a location profile/attribute database in Eldering with the location identification code in the present application. Applicants respectfully note in response that what Eldering at paragraph 0051 in fact discloses is:

[0051] The subscriber profiler 230 may use the data from the location profile/attribute database 320 to identify the type of establishments that the subscriber 210 may pass on the predicted routes. Furthermore, the subscriber profiler 230 may generate a profile of the subscriber based on the data from the two databases 310, 320. The subscriber profile may include a probabilistic determination of the demographic make-up (i.e., race, age, gender, income), and the preferences (i.e., product, store) of the subscriber 210.

That is, Eldering at paragraph 0051 discloses using the data from a location profile/attribute database to identify the type of establishments that a subscriber may pass on a predicted route. The location identification code of the claims of the present application is included in the location specific device. By contrast, the data of Eldering is not comprised in a location specific device. Instead, the data of Eldering is stored in a location profile/attribute database, which itself is not comprised in a location specific device. Furthermore, the data of Eldering is a profile of establishments around a location, not a location identification code. As for the other limitations in the first element of claim 1, Eldering at paragraph 0051 does not even mention 'identifying a client device at a location of a location specific device,' 'client device attributes,' 'client device identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not place in possession of one of ordinary skill in the art each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0034, the Office Action attempts to equate the towers of Eldering with the location specific device in the present application. Applicants respectfully note in response that what Eldering at paragraph 0034 in fact discloses is:

[0034] As illustrated, the wireless network 100 consists of three towers 140. As one of ordinary skill in the art would recognize, the wireless network 100 would consist of a plurality of towers, with the number depending on the size of the network. As illustrated each of the towers 140 include multiple receivers 150. In practice, different wireless service providers operating out of that location probably have their own receiver 150 on the tower 140. The service provider may only handle calls for their customers or it may also contract with other wireless providers to provide service for their customers. For example, if Verizon did not provide wireless service in California, they may contract with Pacific Bell for Pacific Bell to handle the wireless communications for them in California.

That is, Eldering at paragraph 0034 merely describes a wireless network that consists of three towers, each of the towers including multiple receivers. As described above, Eldering's wireless system does not disclose identifying a client device at a location of a location specific device as claimed in the present application because Eldering has no single location for a location specific device. The wireless system of Eldering instead merely estimates the location of the wireless device somewhere in the wireless system using multiple receiver towers or a GPS chipset. Eldering never estimates the wireless device at any location of a single tower. In fact, Eldering cannot do so, because Eldering uses triangulation with multiple towers to estimate the location of the wireless device. The wireless system of Eldering, therefore, does not identify a client device at a location of a location specific device as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0034 does not even mention 'identifying a client device at a location of a location specific device,' 'client device attributes,' 'client device identification code,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not place in possession of one of ordinary skill in the art each and every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Eldering at paragraph 0040, the Office Action attempts to equate the subscriber characteristics in a subscriber profile of Eldering with the client device attributes in the present application. Applicants respectfully note in response that what Eldering at paragraph 0040 in fact discloses is:

[0040] Thus in a preferred embodiment, characteristics about the subscriber (i.e., a subscriber profile) will be known so that the delivery of advertisements, services and information can be tailored (targeted) to that subscriber. For example, if you know that the subscriber likes nice cars you may send him an advertisement for the local BMW dealers in the local area. The characteristics about the subscriber may include demographics, psychographics, product preferences, service preferences, hobbies, likes, dislikes, other categories, or combinations thereof. The characteristics may be provided by the subscriber, may be generated based on actions of the subscriber, or some combination thereof. The subscriber may provide the information by filling out a survey or may simply provide any information they decide is relevant and worth sharing. The actions that may be used to characterize the subscriber include but are not limited to purchases (products and/or services), channel changes, Internet browsing, locations visited, routes, other transactions, and combinations thereof.

That is, Eldering at paragraph 0040 discloses specifying subscriber characteristics in a subscriber profile so that the delivery of advertisements, services, and information can be tailored to that subscriber. Client device attributes as claimed in the present application, however, are attributes of a client device. Eldering's subscriber characteristics in a subscriber profile describe a person—not a client device. That is, Eldering's subscriber characteristics in a subscriber profile are attributes of a person—not attributes of a client device. Furthermore, Eldering's subscriber characteristics in a subscriber profile cannot be client device attributes as claimed in the present application because the subscriber characteristics in a subscriber profile does not include a client device identification code as claimed in the present application. As for the other limitations in the first element of claim 1, Eldering at paragraph 0040 does not even mention 'identifying a client device at a location of a location specific device,' 'location identification code,' or 'identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code.' Because Eldering does not place in possession of one of ordinary skill in the art each and

every element and limitation of Applicants' claims, Eldering does not anticipate Applicants' claims, and the rejections should be withdrawn.

Relations Among Claims

Independent claim 1 claims method aspects for communication of location specific content to client devices of the present invention. Independent claims 28 and 55 respectively claim system and computer program product aspects for communication of location specific content to client devices according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 28 and 55 are allowable for the same reasons that claim 1 is allowable. The rejections of claims 28 and 55 therefore should be withdrawn, and claims 28 and 55 should be allowed.

Claims 4-6, 14-15, 20, and 24-27 depend from independent claim 1. Claims 31-33, 41-42, 47, and 51-54 depend from independent claim 28. Claims 58-60, 68-69, 74, and 78-81 depend from independent claim 55. Each dependent claim includes all of the limitations of independent claim from which it depends. The rejections of claims 4-6, 14-15, 20, 24-27, 31-33, 41-42, 47, 51-54, 58-60, 68-69, 74, and 78-81 therefore should be withdrawn, and these claims also should be allowed.

In addition to the elements and limitations of the independent claims 1, 28, and 55, the dependent claims 4-6, 14-15, 20, 24-27, 31-33, 41-42, 47, 51-54, 58-60, 68-69, 74, and 78-81 also include such elements and limitations as follows: 'a personal digital assistant enabled for wireless data communications,' 'a hand-held personal computer enabled for wireless data communications,' 'the client device comprises a special purpose device enabled for wireless data communications,' 'user preferences for a client device comprises accepting indications of user preference entered by a user through the client device,' 'recording user preferences for a client device comprises accepting user instructions entered by a user through the client device,' 'user instructions include an instruction to change the level of detail of presentation of content,' 'enabling retention of the content within the client device only while the client device is present at the location of the location specific device,' 'storing the content in a microcomputer physically located at the

location of the location specific device,’ ‘storing the content in a content server located remotely from the location specific device,’ and ‘the content server is coupled for data communications through a multiplicity of location specific devices to a multiplicity of client devices.’ In addition to not disclosing the elements of the independent claims 1, 28, and 55, Eldering also does not disclose these additional elements. The rejections of claims 4-6, 14-15, 20, 24-27, 31-33, 41-42, 47, 51-54, 58-60, 68-69, 74, and 78-81, therefore, should be withdrawn, and these claims also should be allowed.

**ARGUMENT REGARDING THE SECOND GROUND OF REJECTION: CLAIMS
2-3, 7-13, 29-30, 34-40, 56-57, AND 61-67 ARE REJECTED UNDER 35 U.S.C § 103(A)
AS BEING ANTICIPATED BY ELDERING, ET AL. (U.S. PUBLICATION NO. 20020111154)
IN VIEW OF BALOG, ET AL. (U.S. PUBLICATION NO. 20020022453)**

Claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Balog, *et al.* (U.S. Publication No. 20020022453). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Eldering and Balog must teach or suggest all of Applicants’ claim limitations. *In re Rayka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Eldering and Balog. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Eldering and Balog. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the combination of Eldering and Balog does not establish a prima facie case of obviousness. The rejection of claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67.

The Proposed Combination Of Eldering And Balog
Does Not Teach Or Suggest All Of The Claim
Limitations Of Applications Claims

To establish a prima facie case of obviousness, the proposed combination of Eldering and Balog must teach or suggest all of the claim limitations of dependent claims 2-3 and 7-13. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Final Office Action relies on the previous 35 U.S.C. § 102 rejection above to reject claims 2-3, and 7-13. As Applicants have demonstrated above, Eldering does not disclose each and every element of independent claims 1, 28, and 55. Dependent claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67 depend from independent claims 1, 28, and 55 and include all of the limitations of the claims from which they depend. Because the proposed combination of Eldering and Balog relies on the argument that Eldering discloses each and every element of claims 1, 28, and 55, and because Eldering does not disclose each and every element of claims 1, 28, and 55, the proposed combination of Eldering and Balog cannot teach or suggest all the claim limitations of claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67. The proposed combination of Eldering and Balog, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

There Is No Suggestion Or Motivation To
Combine Eldering And Balog

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Eldering and Balog. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The suggestion or motivation to combine Eldering and Balog must come from the teaching of either Eldering or Balog themselves, and the Examiner must explicitly point to the teaching within Eldering or Balog suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “indsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991);

In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Final Office Action cites Balog at paragraph 1 in an attempt to explicitly point to a teaching that suggests the proposed combination of Eldering and Balog. Applicants respectfully note, however, that what Balog at paragraph 0001 in fact discloses is:

[0001] The present invention relates to the distribution of content in a mobile communication network, more particularly it relates to determining an optimal protocol and to selecting a device for successful content delivery.

That is, Balog at paragraph 0001 discloses determining an optimal protocol and to selecting a device for successful content delivery. Balog generally discloses delivering content to a plurality of mobile devices communicatively coupled to each other via Bluetooth technology and participating in a communication network. *See* Balog at Abstract. Eldering, however, generally discloses matching data to a subscriber based on a location of the subscriber and a profile of the subscriber. *See* Eldering at Abstract. Balog's disclosure at paragraph 0001 of determining an optimal protocol and to selecting a device for successful content delivery does not suggest or motivate the combination of Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Balog's delivering content to a plurality of mobile devices communicatively coupled to each other via Bluetooth technology. In fact, Balog at paragraph 0001 has nothing whatsoever to do with combining Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Balog's delivering content to a plurality of mobile devices communicatively coupled to each other via Bluetooth technology. Balog at paragraph 0001 merely sets forth the field of the invention in Balog. Because the Office Action does not point to an explicit teaching in either Eldering or Balog that suggests or motivates the combination of Eldering and Balog, the Office Action does not establish a *prima facie* case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

**ARGUMENT REGARDING THE THIRD GROUND OF REJECTION: CLAIMS
16-19, 21, 43-46, 48, 70-73, AND 75 ARE REJECTED UNDER 35 U.S.C § 103(A) AS
BEING ANTICIPATED BY ELDERING, ET AL. (U.S. PUBLICATION NO. 20020111154)
IN VIEW OF HICKS, III, ET AL. (U.S. PUBLICATION NO. 20040261112)**

Claims 16-19, 21, 43-46, 48, 70-73, and 75 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Hicks, III, *et al.* (U.S. Publication No. 20040261112). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Eldering and Hicks must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Eldering and Hicks. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Eldering and Hicks. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the combination of Eldering and Hicks does not establish a prima facie case of obviousness. The rejection of claims 16-19, 21, 43-46, 48, 70-73, and 75 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 16-19, 21, 43-46, 48, 70-73, and 75.

The Proposed Combination Of Eldering And Hicks
Does Not Teach Or Suggest All Of The Claim
Limitations Of Applications Claims

To establish a prima facie case of obviousness, the proposed combination of Eldering and Hicks must teach or suggest all of the claim limitations of dependent claims 16-19 and 21. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Final Office Action relies on the previous 35 U.S.C. § 102 rejection above to reject claims 16-19 and 21. As Applicants have demonstrated above, Eldering does not disclose each and every element of independent claims 1, 28, and 55. Dependent claims 16-19, 21, 43-46, 48, 70-73, and 75 depend from independent

claims 1, 28, and 55 and include all of the limitations of the claims from which they depend. Because the proposed combination of Eldering and Hicks relies on the argument that Eldering discloses each and every element claims 1, 28, and 55, and because Eldering does not disclose each and every element claims 1, 28, and 55, the proposed combination of Eldering and Hicks cannot teach or suggest all the claim limitations of claims 16-19, 21, 43-46, 48, 70-73, and 75. The proposed combination of Eldering and Hicks, therefore, cannot establish a *prima facie* case of obviousness, and the rejections should be withdrawn.

There Is No Suggestion Or Motivation To
Combine Eldering And Hicks

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine Eldering and Hicks. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The suggestion or motivation to combine Eldering and Hicks must come from the teaching of either Eldering or Hicks themselves, and the Examiner must explicitly point to the teaching within Eldering or Hicks suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Final Office Action cites Hicks at paragraphs 0005 and 0006 in an attempt to explicitly point to a teaching that suggests the proposed combination of Eldering and Hicks. Applicants respectfully note, however, that what Hicks at paragraphs 0005 and 0006 in fact discloses is:

[0005] The enhanced digital STBs are usually more expensive than a basic digital STB. Service providers have estimated that most households will be unlikely to purchase more than one of the enhanced digital STBs because of the significantly higher costs associated with the enhanced digital STBs (e.g., including Web-

enablement, a hard drive, a second tuner). Although many consumers will have multiple digital STBs in their homes, it is likely that only one digital STB per home will be an enhanced digital STB. Therefore, consumers will only have access to enhanced services--such as video/audio on demand, interactive TV, Web surfing, e-mail, electronic shopping and recording/storing/playback of broadcast programs--when they are using their enhanced digital STB.

[0006] In view of the foregoing, it can be appreciated that a substantial need exists for systems and methods that can advantageously provide for multimedia on demand services.

That is, Hicks at paragraphs 0005 and 0006 discloses that a substantial need exists for systems and methods that can advantageously provide for multimedia on demand services because many consumer will likely have only one enhanced digital set-top-boxes ('STBs') in their home. Hicks generally discloses an entertainment system for multimedia on demand. *See* Hicks at paragraph 0001. As mentioned above, Eldering generally discloses matching data to a subscriber based on a location of the subscriber and a profile of the subscriber. *See* Eldering at Abstract. Hicks's disclosure at paragraphs 0005 and 0006 of a substantial need that exists for systems and methods that can provide for multimedia on demand services does not suggest or motivate the combination of Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Hicks's entertainment system for multimedia on demand. In fact, Hicks at paragraphs 0005 and 0006 has nothing whatsoever to do with combining Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Hicks's entertainment system for multimedia on demand. Hicks at paragraphs 0005 and 0006 merely provides background explaining the need for Hick's entertainment system for multimedia on demand. Because the Office Action does not point to an explicit teaching in either Eldering or Hicks that suggests or motivates the combination of Eldering and Hicks, the Office Action does not establish a *prima facie* case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

**ARGUMENT REGARDING THE FOURTH GROUND OF REJECTION: CLAIMS
22, 23, 49, 50, 76, AND 77 ARE REJECTED UNDER 35 U.S.C § 103(A) AS BEING
ANTICIPATED BY ELDERING, ET AL. (U.S. PUBLICATION NO. 20020111154)
IN VIEW OF KIM, ET AL. (U.S. PUBLICATION NO. 20020052925)**

Claims 22, 23, 49, 50, 76, and 77 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Eldering, *et al.* (U.S. Publication No. 20020111154) in view of Kim, *et al.* (U.S. Publication No. 20020052925). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Eldering and Kim must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Eldering and Kim. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Eldering and Kim. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the combination of Eldering and Kim does not establish a prima facie case of obviousness. The rejection of claims 22, 23, 49, 50, 76, and 77 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 22, 23, 49, 50, 76, and 77.

The Proposed Combination Of Eldering And Kim
Does Not Teach Or Suggest All Of The Claim
Limitations Of Applications Claims

To establish a prima facie case of obviousness, the proposed combination of Eldering and Kim must teach or suggest all of the claim limitations of dependent claims 22 and 23. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Final Office Action relies on the previous 35 U.S.C. § 102 rejection above to reject claims 22 and 23. As Applicants have demonstrated above, the Eldering does not disclose each and every element of independent

claims 1, 28, and 55. Dependent claims 22, 23, 49, 50, 76, and 77 depend from independent claims 1, 28, and 55 and include all of the limitations of the independent claims from which they depend. Because the proposed combination of Eldering and Kim relies on the argument that the Eldering discloses each and every element of claims 1, 28, and 55, and because Eldering does not disclose each and every element claims 1, 28, and 55, the proposed combination of Eldering and Kim cannot teach or suggest all the claim limitations of claims 22, 23, 49, 50, 76, and 77. The proposed combination of Eldering and Kim, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

There Is No Suggestion Or Motivation To
Combine Eldering And Kim

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Eldering and Kim. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The suggestion or motivation to combine Eldering and Kim must come from the teaching of either Eldering or Kim themselves, and the Examiner must explicitly point to the teaching within Eldering or Kim suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Final Office Action cites Kim at paragraph 0044 in an attempt to explicitly point to a teaching that suggests the proposed combination of Eldering and Kim. Applicants respectfully note, however, that what Kim at paragraph 0044 in fact discloses is:

[0044] This invention continuously monitors the user's activity while the user is on line and downloads advertising materials when the user's activity is low,

storing the materials in the user's local storage. Thus a large amount of information, such as multi-media, can be downloaded without slowing down the user's activity even over a narrow band channel. For the presentation of materials, the present invention utilizes the transition time from one page to another where users must typically endure blank screens and are waiting for the new web page downloading. Since the materials are already stored in the user's local storage before presentation, presentation of large materials, such as TV-like advertisements are executed instantly without further download. The presentation materials include advertisements, multi-media data, cartoons, study material, and news broadcasts.

That is, Kim at paragraph 0044 discloses continuously monitoring the user's activity while the user is on line and downloading advertising materials when the user's activity is low, storing the materials in the user's local storage. Kim generally discloses delivering targeted multimedia or video advertisements over the Internet while protecting user privacy. *See Kim at Abstract.* As mentioned above, Eldering generally discloses matching data to a subscriber based on a location of the subscriber and a profile of the subscriber. *See Eldering at Abstract.* Kim's disclosure at paragraph 0044 of downloading advertising materials when the user's activity is low does not suggest or motivate the combination of Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Kim's delivering targeted multimedia or video advertisements over the Internet while protecting user privacy. In fact, Kim at paragraph 0044 has nothing whatsoever to do with combining Eldering's matching data to a subscriber based on a location of the subscriber and a profile of the subscriber with Kim's delivering targeted multimedia or video advertisements over the Internet while protecting user privacy. Kim at paragraph 0044 merely sets forth a portion of a summary of the invention in Kim. Because the Office Action does not point to an explicit teaching in either Eldering or Kim that suggests or motivates the combination of Eldering and Kim, the Office Action does not establish a *prima facie* case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

CONCLUSION OF APPLICANTS' ARGUMENTS

Claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, and 51-54, 55, 58-60, 68-69, 74, and 78-81 stand rejected under 35 U.S.C § 102(e) as being anticipated by Eldering, *et al.* (U.S. Publication No. 20020111154). For the reasons set forth above, Eldering does not anticipate claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, and 51-54, 55, 58-60, 68-69, 74, and 78-81. Applicants therefore traverse the rejections individually to claims 1, 4-6, 14-15, 20, 24-27, 28, 31-33, 41-42, 47, and 51-54, 55, 58-60, 68-69, 74, and 78-81 under 35 U.S.C § 102(e) and respectfully request the withdrawal of the rejections.

Claims 2-3, 7-13, 29-30, 34-40, 56-57, and 61-67 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Eldering, in view of Balog, *et al.* (U.S. Publication No. 20020022453). Claims 16-19, 21, 43-46, 48, 70-73, and 75 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Eldering, in view of Hicks, III, *et al.* (U.S. Publication No. 20040261112). Claims 22, 23, 49, 50, 76, and 77 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Eldering, in view of Kim, *et al.* (U.S. Publication No. 20020052925). Eldering, either alone or in combination with Balog, Hicks, or Kim, does not teach or suggest a method, system, or computer program product for communication of location specific content to client devices as claimed in the present application. For the reasons set forth above, the proposed combinations of Eldering with Balog, Hicks, or Kim do not establish a *prima facie* case of obviousness. Applicants therefore traverse the rejections individually to claims 2-3, 7-13, 29-30, 34-40, 56-57, 61-67, 16-19, 21, 43-46, 48, 70-73, 75, 22, 23, 49, 50, 76, and 77 under 35 U.S.C § 103(a) and respectfully request the withdrawal of the rejections.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: August 8, 2006

Respectfully submitted,

By:



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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
NEWTON J. SMITH, JR., ET AL., SERIAL NO. 09/942,757

CLAIMS

What is claimed is:

1. A method for communication of location specific content to client devices, the method comprising the steps of:
 - identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;
 - recording user preferences for the client device;
 - selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;
 - transmitting the selected content through the location specific device to the client device for presentation; and
 - enabling retention of the content within the client device for a period of time.
2. The method of claim 1 wherein the location identification code comprises a network address.
3. The method of claim 1 wherein the client device identification code comprises a network

address.

4. The method of claim 1 wherein the client device comprises a personal digital assistant enabled for wireless data communications.
5. The method of claim 1 wherein the client device comprises a hand-held personal computer enabled for wireless data communications.
6. The method of claim 1 wherein the client device comprises a special purpose device enabled for wireless data communications.
7. The method of claim 1 further comprising transcoding the content in dependence upon the client device attributes.
8. The method of claim 1 wherein the client device attributes include a client device type.
9. The method of claim 1 wherein the client device attributes comprise presentation capabilities.
10. The method of claim 9 wherein the presentation capabilities include display screen size.
11. The method of claim 9 wherein the presentation capabilities include color availability.
12. The method of claim 9 wherein the presentation capabilities include audio availability.
13. The method of claim 9 wherein the presentation capabilities include a video frame rate.
14. The method of claim 1 wherein recording user preferences for a client device comprises accepting indications of user preference entered by a user through the client device.
15. The method of claim 1 wherein recording user preferences for a client device comprises

accepting user instructions entered by a user through the client device.

16. The method of claim 15 wherein user instructions include an instruction to pause presentation of content.
17. The method of claim 15 wherein user instructions include an instruction to resume presentation of content.
18. The method of claim 15 wherein user instructions include an instruction to rewind presentation of content.
19. The method of claim 15 wherein user instructions include an instruction to fast forward presentation of content.
20. The method of claim 15 wherein user instructions include an instruction to change the level of detail of presentation of content.
21. The method of claim 1 wherein the content comprises programs and the user instructions include an instruction to change from one program to another.
22. The method of claim 1 wherein enabling retention of the content within the client device for a period of time further comprises transmitting through the location specific device to the client device an expiration date and time for the selected content transmitted to the device for presentation.
23. The method of claim 22 wherein enabling retention of the content within the client device for a period of time further comprises altering the expiration date and time.
24. The method of claim 22 wherein enabling retention of the content within the client device for a period of time further comprises enabling retention of the content within the client device only while the client device is present at the location of the location specific

device.

25. The method of claim 1 further comprising storing the content in a microcomputer physically located at the location of the location specific device.

26. The method of claim 1 further comprising storing the content in a content server located remotely from the location specific device.

27. The method of claim 26 wherein the content server is coupled for data communications through a multiplicity of location specific devices to a multiplicity of client devices.

28. A system for communication of location specific content to client devices, the system comprising:

means for identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

means for recording user preferences for the client device;

means for selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

means for transmitting the selected content through the location specific device to the client device for presentation; and

means for enabling retention of the content within the client device for a period of time.

29. The system of claim 28 wherein the location identification code comprises a network address.

30. The system of claim 28 wherein the client device identification code comprises a network address.
31. The system of claim 28 wherein the client device comprises a personal digital assistant enabled for wireless data communications.
32. The system of claim 28 wherein the client device comprises a hand-held personal computer enabled for wireless data communications.
33. The system of claim 28 wherein the client device comprises a special purpose device enabled for wireless data communications.
34. The system of claim 28 further comprising means for transcoding the content in dependence upon the client device attributes.
35. The system of claim 28 wherein the client device attributes include a client device type.
36. The system of claim 28 wherein the client device attributes comprise presentation capabilities.
37. The system of claim 36 wherein the presentation capabilities include display screen size.
38. The system of claim 36 wherein the presentation capabilities include color availability.
39. The system of claim 36 wherein the presentation capabilities include audio availability.
40. The system of claim 36 wherein the presentation capabilities include a video frame rate.
41. The system of claim 28 wherein means for recording user preferences for a client device comprises means for accepting indications of user preference entered by a user through

the client device.

42. The system of claim 28 wherein means for recording user preferences for a client device comprises means for accepting user instructions entered by a user through the client device.

43. The system of claim 28 wherein user instructions include an instruction to pause presentation of content.

44. The system of claim 28 wherein user instructions include an instruction to resume presentation of content.

45. The system of claim 28 wherein user instructions include an instruction to rewind presentation of content.

46. The system of claim 28 wherein user instructions include an instruction to fast forward presentation of content.

47. The system of claim 28 wherein user instructions include an instruction to change the level of detail of presentation of content.

48. The system of claim 28 wherein the content comprises programs and the user instructions include an instruction to change from one program to another.

49. The system of claim 28 wherein means for enabling retention of the content within the client device for a period of time further comprises means for transmitting through the location specific device to the client device an expiration date and time for the selected content transmitted to the device for presentation.

50. The system of claim 49 wherein means for enabling retention of the content within the client device for a period of time further comprises means for altering the expiration date

and time.

51. The system of claim 49 wherein means for enabling retention of the content within the client device for a period of time further comprises means for enabling retention of the content within the client device only while the client device is present at the location of the location specific device.
52. The system of claim 28 further comprising means for storing the content in a microcomputer physically located at the location of the location specific device.
53. The system of claim 28 further comprising means for storing the content in a content server located remotely from the location specific device.
54. The system of claim 53 wherein the content server is coupled for data communications through a multiplicity of location specific devices to a multiplicity of client devices.
55. A computer program product for communication of location specific content to client devices, the computer program product comprising:

a recording medium;

means, recorded on the recording medium, for identifying a client device at a location of a location specific device, wherein the client device comprises client device attributes, the client device attributes comprising a client device identification code, and wherein the location specific device comprises a location identification code;

means, recorded on the recording medium, for recording user preferences for the client device;

means, recorded on the recording medium, for selecting, in dependence upon the user preferences for the client device and upon the location identification code, content for transmission to the client device;

means, recorded on the recording medium, for transmitting the selected content through the location specific device to the client device for presentation; and

means, recorded on the recording medium, for enabling retention of the content within the client device for a period of time.

56. The computer program product of claim 55 wherein the location identification code comprises a network address.
57. The computer program product of claim 55 wherein the client device identification code comprises a network address.
58. The computer program product of claim 55 wherein the client device comprises a personal digital assistant enabled for wireless data communications.
59. The computer program product of claim 55 wherein the client device comprises a hand-held personal computer enabled for wireless data communications.
60. The computer program product of claim 55 wherein the client device comprises a special purpose device enabled for wireless data communications.
61. The computer program product of claim 55 further comprising means, recorded on the recording medium, for transcoding the content in dependence upon the client device attributes.
62. The computer program product of claim 55 wherein the client device attributes include a client device type.

63. The computer program product of claim 55 wherein the client device attributes comprise presentation capabilities.
64. The computer program product of claim 63 wherein the presentation capabilities include display screen size.
65. The computer program product of claim 63 wherein the presentation capabilities include color availability.
66. The computer program product of claim 63 wherein the presentation capabilities include audio availability.
67. The computer program product of claim 63 wherein the presentation capabilities include a video frame rate.
68. The computer program product of claim 55 wherein means, recorded on the recording medium, for recording user preferences for a client device comprises means, recorded on the recording medium, for accepting indications of user preference entered by a user through the client device.
69. The computer program product of claim 55 wherein means, recorded on the recording medium, for recording user preferences for a client device comprises means, recorded on the recording medium, for accepting user instructions entered by a user through the client device.
70. The computer program product of claim 55 wherein user instructions include an instruction to pause presentation of content.
71. The computer program product of claim 55 wherein user instructions include an instruction to resume presentation of content.

72. The computer program product of claim 55 wherein user instructions include an instruction to rewind presentation of content.
73. The computer program product of claim 55 wherein user instructions include an instruction to fast forward presentation of content.
74. The computer program product of claim 55 wherein user instructions include an instruction to change the level of detail of presentation of content.
75. The computer program product of claim 55 wherein the content comprises programs and the user instructions include an instruction to change from one program to another.
76. The computer program product of claim 55 wherein means, recorded on the recording medium, for enabling retention of the content within the client device for a period of time further comprises means, recorded on the recording medium, for transmitting through the location specific device to the client device an expiration date and time for the selected content transmitted to the device for presentation.
77. The computer program product of claim 76 wherein means, recorded on the recording medium, for enabling retention of the content within the client device for a period of time further comprises means, recorded on the recording medium, for altering the expiration date and time.
78. The computer program product of claim 76 wherein means, recorded on the recording medium, for enabling retention of the content within the client device for a period of time further comprises means, recorded on the recording medium, for enabling retention of the content within the client device only while the client device is present at the location of the location specific device.
79. The computer program product of claim 55 further comprising means, recorded on the

recording medium, for storing the content in a microcomputer physically located at the location of the location specific device.

80. The computer program product of claim 55 further comprising means, recorded on the recording medium, for storing the content in a content server located remotely from the location specific device.

81. The computer program product of claim 80 wherein the content server is coupled for data communications through a multiplicity of location specific devices to a multiplicity of client devices.

**APPENDIX OF EVIDENCE
ON APPEAL IN PATENT APPLICATION OF
NEWTON J. SMITH, JR., ET AL., SERIAL NO.09/942,757**

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).

There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).